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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/270,006 03/16/99 ROBIN

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EXAMINER

BALASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

09/270,006

Applicant(s)

ROBIN ET AL.

Examiner

Venkataraman  
Balasubramanian

Art Unit

1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 12 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 88-101.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14.
10. ☒ Other: See attached Letter

### LETTER

Applicants' response filed 7/12/2001 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered for the following reason.

Claims 88-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. Yaoxue Xuebao (Acta. Pharm. Sinica) 27, 178-184, 1992(Wang I) and Huang et al, the Alkaloids, Vol. XXII 157-225, 1984 in view of Wang et al. Yaoxue Xuebao (Acta. Pharm. Sinica) 27, 173-177, 1992(Wang II) for reasons of record.

Following also apply:

1. Contrary to applicants' urging, examiner has made a prime facie case of obviousness. As noted before, Wang I teaches the tetrahydrofuran and tetrahydropyran esters of cephalotaxine. Wang I differs in not making the tetrahydrofuran or pyran carboxylic acid first. Huang et al. teaches the process for hydrolyzing the cephalotaxine alkaloids and the synthesis of the acid components. Wang II teaches a process for cyclizing the open chain acid i.e. compound 7 bearing a CTX group to the corresponding tetrahydrofuran compound. Note the starting materials are analogous in that they are compound of formula 7 with a methoxy on the tertiary carboxylic group or CTX. Thus one having ordinary skill in the art at the time of the invention was made would have been motivated to combine both the primary and secondary references and employ the process taught by these prior art to the starting materials and expect

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to obtain the desired product because he would have expected the analogous starting materials and reactants react similarly.

2. Applicants also argue that it is impossible to arrive at the desired product as Reformatsky reaction will not work in presence of hydroxyl group (see page 3-4 of remarks) but have failed to provide any evidence that such is the case. Contrary to applicants' urging, the Information Disclosure Statement provided by the applicants indicate that the Reformatsky reaction is viable in presence of hydroxyl group(s). See Hudlicky et al. page 663, compound 104.

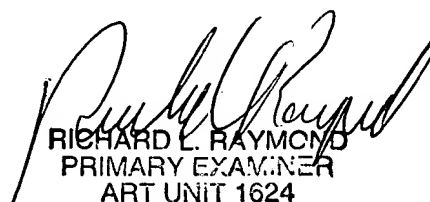
Hence this rejection made in the previous office action is proper and is maintained.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM. The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

VB

V. Balasubramanian (Bala)

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624

7/20/2001